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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/721,818	11/24/2003	David N. Brauneis	RSW920030280US1	6268
51016 7590 01/24/2008 IBM CORP. (RALEIGH SOFTWARE GROUP) c/o Rudolf O Siegesmund Gordon & Rees, LLP 2100 Ross Avenue Suite 2800 DALLAS, TX 75201			EXAMINER STEELMAN, MARY J	
			ART UNIT 2191	PAPER NUMBER
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

AK

<b>Office Action Summary</b>	<b>Application No.</b> 10/721,818	<b>Applicant(s)</b> BRAUNEIS ET AL.	
	<b>Examiner</b> MARY STEELMAN	<b>Art Unit</b> 2191	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 24 November 2003.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-27 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-27 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on 24 November 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date <u>11/24/2003</u> . | 6) <input type="checkbox"/> Other: _____  |

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### **DETAILED ACTION**

1. Claims 1-27 are pending.

#### ***Information Disclosure Statement***

2. IDS received 11/24/2003 has been considered.

#### ***Specification***

3. The use of the trademark JAVA has been noted in this application. It should be capitalized wherever it appears and be accompanied by the generic terminology.

Although the use of trademarks is permissible in patent applications, the proprietary nature of the marks should be respected and every effort made to prevent their use in any manner which might adversely affect their validity as trademarks.

#### ***Claim Objections***

4. Acronyms, in parenthesis, should follow a fully spelled version of the meaning, at the first use. See claims 8, 9, 17, 18, 26, and 27.

#### ***Claim Rejections - 35 USC § 112***

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

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6. Claims 9, 18, and 27 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

See MPEP 7.35.01 Trademark or Trade Name as a Limitation in the Claim

Claims contain the trademark/trade name JAVA. Where a trademark or trade name is used in a claim as a limitation to identify or describe a particular material or product, the claim does not comply with the requirements of 35 U.S.C. 112, second paragraph. See *Ex parte Simpson*, 218 USPQ 1020 (Bd. App. 1982). The claim scope is uncertain since the trademark or trade name cannot be used properly to identify any particular material or product. A trademark or trade name is used to identify a source of goods, and not the goods themselves. Thus, a trademark or trade name does not identify or describe the goods associated with the trademark or trade name. In the present case, the trademark/trade name is used to identify/describe byte code programming language and, accordingly, the identification/description is indefinite.

The trademark JAVA is improperly relied upon in the claims to incorporate the technical features of a particular programming language environment. However, the trademark JAVA can only properly define the source of the programming language environment, namely Sun Microsystems, Inc. Accordingly, the identification/description is indefinite.

Sun Microsystems, Inc. is the sole producer and/or licensor of JAVA products. The trademark JAVA identifies the source of the products and not the products themselves. In contrast, for

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example, C++ is a name used in trade to identify a particular nonproprietary programming language conforming to an accepted standard. Products and services incorporating the name C++ are produced by numerous sources. Further, the technologies identified using the trademark JAVA are continuously evolving. An example of this evolution can be found in "JSR 14: Add Generic Types To The Java™ Programming Language", which describes a proposed amendment to the JAVA Language Specification submitted by Sun Microsystems, Inc., in 1999 and pending approval by the JAVA COMMUNITY PROCESS Program. In view of the statements presented above, it is asserted that the trademark JAVA has no fixed definite technical meaning. Accordingly, a rejection under 35 U.S.C. 112, second paragraph, based on the use of the trademark JAVA as a limitation in a claim, is proper.

7. Claims 5, 14, and 23 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 5, 14, and 23 recite the limitation "the duplication" in the last line. There is insufficient antecedent basis for this limitation in the claim.

#### ***Claim Rejections - 35 USC § 101***

8. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

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9. Claims 10 – 18 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. Claims are directed to "a web application development tool..." A "tool" is software per se, and, as such, is not a statutory embodiment.

***Claim Rejections - 35 USC § 102***

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

10. Claims 1, 10, and 19 are rejected under 35 U.S.C. 102(b) as being anticipated by USPN 6,336,122 B1 to Lee et al.

Per claims 1, 10, and 19:

A method (tool / computer program product) for packaging a web application, comprising:

-receiving a first web application module and a second web application module, the first and second modules each comprising a plurality of resources, each resource comprising information; -identifying:

-those resources of the first module which are related to a corresponding resource in the second module;

-those resources of the first module which are independent of resources in the second module; and merging each set of corresponding related resources.

Lee disclosed:

Col. 2: 42-57, A tool archive maker that operates on one or more existing archive files (receiving first and second web application module) of object oriented classes to generate one or more new

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archive files. A new archive file includes all required (related, independent) and dependent classes. Classes not required are stripped out (merging each set of corresponding related resources, not including resources which are independent of resources in the second module). The archive maker may consolidate multiple existing archive files into a single new archive file.

Lee disclosed (col. 4: 19) a classic object model, a client object sends request messages to server objects to perform any necessary or desired function. Lee disclosed (col. 4: 38) JAVA specifically designed to create small application programs, commonly called applets that reside on the network in centralized servers, and which are delivered to the client machine (web applications).

### ***Claim Rejections - 35 USC § 103***

11. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

12. Claims 2-9, 11-18, and 20-27 are rejected under 35 U.S.C. 103(a) as being unpatentable over USPN 6,336,122 B1 to Lee et al., in view of US patent 7,069,553 B2 to Narayanaswamy et al.

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Per claims 2, 11, and 20:

-merging a set of related resources comprises determining if information in a resource in the first module conflicts with information in the corresponding resource in the second module.

Lee: Col. 8: 41-54, "One potential problem (conflict)...is that there may be classes that are needed that do not exist in the source archive...the archive maker will determine that there are dependencies...application or applet is run to **determine** if there are any classes missing (conflict)..." Col. 11: 53-56, To handle conflict, Lee disclosed "a SUBSTITUTE command that might specify an archive file and one or more specified files in the archive file that are to be replaced by other specified files.

It is noted that the Specification did not provide details related to the definition of 'conflict.'

More explicitly, Narayanaswamy disclosed packaging for deployment (col. 3: 11) web applications. Col. 3: 47-49, A Deployment wizard interface 102 defines a number of methods and variables that may be implemented to use the deployment tool. Col. 3: 59-63, getPlugin-Bundle, which returns the resource bundle being used...getBundle(), which returns the bundle being used. Col. 5: 46-53, Deployable components may be created by using any one of the available enterprise development environment tools. One such tool is Advantage Joe 3.0, which provides capability for modeling, building, and deploying components onto an application server...combines the JAVA archives (JAR) files and incorporates them into Enterprise archive (EAR) files..."



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Therefore, it would have been obvious, to one of ordinary skill in the art at the time of the invention, to modify Lee, using the teachings of Narayanaswamy, because Lee disclosed developing deployable applications, but Narayanaswamy disclosed a wizard, user interface tool that provides guidance to the developer to correctly select features.

Per claims 3, 12, and 21:

- if information in a resource in the first module does not conflict with information in the corresponding resource in the second module, merging the resources comprises:
- merging the information of the resource in the second module with the information of the corresponding resource in the first module to create a merged resource;
- packaging the merged resource into a web application file.

Lee disclosed: Col. 5: 6-7, consolidate multiple archive files into a larger archivefile Col. 9: 59-63, Archive maker 124 then creates anew archive file... Col. 11: 24-25, CONSOLIDATE – s my\_archive1.jar, my\_archive2.jar, my\_archive3.jar – result.jar (merge into JAVA archive file) Col. 11: 56-59, The CONSOLIDATE command might take an archive file and one or more specified files as input and consolidate the specified files into the archive file.

More explicitly, Narayanaswamy disclosed packaging for deployment (col. 3: 11) web applications. Col. 3: 47-49, A Deployment wizard interface 102 defines a number of methods and variables that may be implemented to use the deployment tool. One such tool is Advantage Joe 3.0, which provides capability for modeling, building, and deploying components onto an

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application server...combines the JAVA archives (JAR) files and incorporates them into Enterprise archive (EAR) files..."

Therefore, it would have been obvious, to one of ordinary skill in the art at the time of the invention, to modify Lee, using the teachings of Narayanaswamy, because Lee disclosed developing deployable applications, but Narayanaswamy disclosed a wizard, user interface tool that provides guidance to the developer to correctly select features.

Per claims 4, 13, and 22:

-packaging the independent resources into the web application file.

Lee disclosed: Col. 5: 8-9, generating new archive files from existing archive files Col. 5: 64, archive maker, 124 Col. 8: 17-24, Archive maker 124 is invoked, specifying the source archive file 123 to use and specifying which classes in archive file 123 must be included...creates a new archive file 125 that contains all specified (independent resources) and dependent classes...

Per claims 5, 14, and 23:

-if information in a resource in the first module conflicts with information in the corresponding resource in the second module, merging the resources comprises indicating to a user of the duplication.

Lee disclosed the CONSOLIDATE (merge) command, but failed to explicitly disclose "indicating to a user of the duplication."

More explicitly, Narayanaswamy disclosed packaging for deployment (col. 3: 11) web applications. Col. 3: 47-49, A Deployment wizard interface 102 defines a number of methods and variables that may be implemented to use the deployment tool.

One such tool is Advantage Joe 3.0, which provides capability for modeling, building, and deploying components onto an application server...combines the JAVA archives (JAR) files and incorporates them into Enterprise archive (EAR) files..." Col. 5: 32-35, deployment tool 104 or 106 may optionally display the contents of the packaged EAR file to be modified. The modifications may be performed using the helper interface dialogs... Col. 10: 13-14, If an error occurs, it throws a DeploymentException (indicating to user). Col. 13: 37, 41 & 46, error status messages, warning status messages, informational status messages, unusual conditions

Therefore, it would have been obvious, to one of ordinary skill in the art at the time of the invention, to modify Lee, using the teachings of Narayanaswamy, because Lee disclosed developing deployable applications, but Narayanaswamy disclosed a wizard, user interface tool that provides guidance to the developer to correctly select features.

Per claims 6, 15, and 24:

Lee failed to disclose:

-if information in a resource in the first module conflicts with information in the corresponding resource in the second module, merging the resources comprises aborting merging of the resources.

More explicitly, Narayanaswamy disclosed (col. 13: 50 & 54), disable (aborting)

Therefore, it would have been obvious, to one of ordinary skill in the art at the time of the invention, to modify Lee, using the teachings of Narayanaswamy, because Lee disclosed developing deployable applications, but Narayanaswamy disclosed a wizard, user interface tool that provides guidance to the developer.

Per claims 7, 16, and 25:

Lee failed to disclose:

-if information in a resource in the first module conflicts with information in the corresponding resource in the second module, merging the resources comprises: removing the information in the resource of the first module; and continuing merging the resources.

More explicitly, Narayanaswamy disclosed using a wizard tool to create EAR files. Col. 15: 5-7, The createEarFile (DeploymentModule de, int appCount) method is used to specify modules and sub-modules to build and EAR file. Col. 15: 20-21, The genContainer (ResourceBundle bundle) method generates the EAR files. Col. 16: 34, information is acquired via the panel (user interface inputs received). Col. 16: 38-57, Once the deployment details have been specified for a server, the EAR file is packaged and displayed. The user may then modify...XML editor may be used to edit...files selected...from a panel showing EJB display tree illustrated in FIG. 7. Once a user selects an XML file, other panels may be activated to open an editor to modify selected portions...

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A wizard tool and user interface panels guide the developer through merging, removing, continuing development.

Therefore, it would have been obvious, to one of ordinary skill in the art at the time of the invention, to modify Lee, using the teachings of Narayanaswamy, because Lee disclosed developing deployable applications, but Narayanaswamy disclosed a wizard, user interface tool that provides guidance to the developer to correctly select features.

Per claims 8, 17, and 26:

-the first and second modules are WAR files.

Lee disclosed merging (col. 2; 44) existing archive files. Lee disclosed JAVA archive files, known as JAR files at col. 4: 51-63.

Lee failed to explicitly disclose WAR files. WAR files are web archive resources. Lee noted (col. 4: 58-60) that the present invention is equally applicable to any archive file for any object oriented programming language that can hold multiple classes.

More explicitly, Narayanaswamy disclosed using a wizard tool. Narayanaswamy disclosed (col. 3: 67 – col. 4: 1) getting ejb (enterprise java beans) references for a war or a project.

Therefore, it would have been obvious, to one of ordinary skill in the art at the time of the invention, to modify Lee, using the teachings of Narayanaswamy, because Lee disclosed

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developing deployable applications, but Narayanaswamy disclosed a wizard, user interface tool that provides guidance to the developer to correctly select features to build war (web archive resource) applications.

Per claims 9, 18, and 27:

-the web application file is a J2EE archive file.

Lee disclosed 'enterprise' JAVA applications, but failed to explicitly disclose 'enterprise' types of archives.

More explicitly, Narayanaswamy disclosed using a wizard tool. Narayanaswamy disclosed (col. 3: 67 – col. 4: 1) getting ejb (enterprise java beans) references for a war or a project. See Narayanaswamy (col. 5: 64 – col. 8 ).

Therefore, it would have been obvious, to one of ordinary skill in the art at the time of the invention, to modify Lee, using the teachings of Narayanaswamy, because Lee disclosed developing deployable applications, but Narayanaswamy disclosed a wizard, user interface tool that provides guidance to the developer to correctly select features to build war (web archive resource) applications.

### ***Conclusion***

13. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

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NOTE: US Patent Application Publication 2005/0108259 A1 to Watanabe et al.

(priority date 11/14/2003)

Watanabe disclosed [0011], acquiring / determining information from web archives [0032], determining process for web pages that miss being gathered (conflict) [0055], web-archiving server 30

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mary Steelman, whose telephone number is (571) 272-3704. The examiner can normally be reached Monday through Thursday, from 7:00 AM to 5:30 PM. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Wei Zhen can be reached at (571) 272-3708. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Any inquiry of a general nature or relating to the status of this application should be directed to the TC 2100 Group receptionist: 571-272-2100.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Mary Steelman

01/08/2008

**MARY STEELMAN**  
**PRIMARY EXAMINER**

